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IN THE

Supreme Court of the United States

OCTOBER TERM, 1972.

No. 72-1536

BRUNNER & LAY, INC.,

Petitioner,

vs.

INGERSOLL-RAND COMPANY,

Respondent.

PETITIONER'S REPLY BRIEF.

EDWARD C. VANDENBURGH III,
DARBO, ROBERTSON & VANDENBURGH,
P. O. Box 670,
Arlington Heights, Illinois 60006,
Counsel for Petitioner.

Gunthorp-Warren Printing Company, Chicago • 346-1717

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REASON I—Impropriety of Court of Appeals Ignoring District Court's Findings of Fact.[1]

The Respondent's brief is primarily an argument that there are facts in the record to support the decision of the Court of Appeals. So far as the petition for certiorari is concerned, this question is essentially irrelevant.[2] The real issue is—must the Court of Appeals respect the requirement of Rule 52(a) FRCP and not retry the fact issues unless the District Court's conclusions were clearly erroneous.

Petitioner's brief detailed five points, essential to the appellate decision that the patent was valid, as to which the Court of Appeals' decision was directly contrary to the findings of fact of the District Court. Respondent's brief says that all of

1. Discussed on pages 5-14 of the Petition for Writ of Certiorari.

2. It is not irrelevant to the appellate court's finding of "synergism" which is completely without factual support in the record. See page 13 of the Petition for Writ of Certiorari.

these are refuted by the record, but proceeds to name only two. These two are discussed in terms calculated to lead to the conclusion that Petitioner is attempting to mislead this Court.

As to the first of the two, the Petitioner is in good company in its statement that there was no novelty in threading a drill rod throughout its length, because all of the following expressed the same view:

Respondent's house counsel (patent lawyers).

Ditson, the inventor on the patent.

The examiner in the patent office.

An expert witness at the trial.

The district court.

Yet, at the urging of the Respondent, the Court of Appeals found this to be novel.

As to the second of the two (i.e. the width of the groove in prior art threading practices), the argument of respondent is an attempt to pin a mouse's tail on an elephant. There is no question but that with small threads (e.g. a screw for a watch) one would need a microscope to see the groove. A jeweler needs a loupe to even find the screw. But, this does not mean that when threading a bar 2½ inches in diameter, the prior art would make the groove correspondingly small. The realistic relationship was to size the groove in relation to the size of the threads being produced. Just this was expressed by one witness who, in speaking of his general—and prior art—procedure in rolling threads, said that he always made the groove 25% of the width of the crest of the threads.

REASON II—Impropriety of Court of Appeals Assuming That Patent Office Examiner Was Aware of Crucial Prior Art.[3]

Aside from the animadversions sprinkled throughout the brief, the Respondent's sole contention on this point is that

3. Discussed on pages 15-18 of the Petition for Writ of Certiorari.

thread rolling was old and therefore it is implied that the patent office examiner must have been aware of it. The "person having ordinary skill in the art" of 35 U. S. C. 103 is omniscient and would have known that prior art thread rolling procedures would have called for a groove to be produced. But the patent office examiner is a mere mortal man. Consequently, the patent office requires that a written record be made to form the exclusive basis of what is considered in the granting of the patent.[4] As exemplified by the testimony of an expert witness at the trial, the absence from that written record of a particular item of knowledge establishes that the examiner did not consider it.

In a situation in which it was shown that the particular examiner in the patent office was supplied with the facts in connection with an application other than the one in question, the Court of Appeals for the Seventh Circuit refused to hold that that individual had the knowledge so far as the application in question was concerned. It said

> "In any event, we think that it is unfair to a busy examiner, no matter how diligent and well informed he may be, to assume that he retains details of every pending file in his mind when he is reviewing a particular application. Especially since Patent Office proceedings are ex parte, the applicant has the burden of presenting the examiner with a complete and accurate record to support the allowance of letters patent. Armour failed to discharge that burden." *Armour and Company* v. *Swift & Company*, 466 F. 2d 767, 779, 7th Cir. 1972.

The rule applied herein by the Fifth Circuit that the examiner will be presumed to have the knowledge is directly contrary thereto.

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4. Patent Office Rule 2.

REASON III—Impropriety in Basing Patent's Validity on the Fact of Copying.[5]

Respondent's brief refers to this as a "straw-man", yet almost a paragraph of the appellate opinion extolled the evidentiary value to its holding of validity of the fact of the Petitioner's copying Respondent's product. Furthermore, Respondent utilizes one whole section of its Brief in Opposition to the Petition to telling how the Petitioner is a "parasite" because it copied.

It is a real issue as to whether or not the public interest is best served by encouraging or discouraging a competitor from contesting patents of doubtful validity or obviously invalid. As explained in the Petition for Certiorari the action of the Court of Appeals for the Fifth Circuit serves to discourage the development of competition no matter how obviously invalid the patent may be.

REASONS IV Through VI.

There are not discussed in Respondent's brief.

Respectfully submitted,

EDWARD C. VANDENBURGH III,
DARBO, ROBERTSON & VANDENBURGH,
P. O. Box 670,
Arlington Heights, Illinois 60006,
Counsel for Petitioner.

5. Discussed on pages 18-20 of the Petition for Writ of Certiorari.